

(Practitioner's Docket No. IPAT-98897/BC1-0046)

REMARKS**1. Amendments**

Please cancel claims 1-7, 16, and 18, and add new claim 19. Support for new claim 19 may be found in the original claims and Specification, but especially on page 18, lines 15-23.

Entry of these amendments is respectfully requested.

2. Rejection of claims 1-5 and 9-16 under 35 U.S.C. §102(b) as being anticipated by or in the alternative as being obvious under 35 U.S.C. §103(a) over Kato et al., U.S. 6,333,367, hereafter "Kato" or "367".**A. Rejection under 35 U.S.C. §102(b).**

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To constitute anticipation, all material elements of a claim must be found in one prior art source. *In re Marshall*, 198 U.S.P.Q. 344 (C.C.P.A. 1978).

Kato fails to satisfy this standard with respect to Applicants' invention of new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

Kato never mentions the word 'bacteria' or the fact that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Kato's disclosure of two bismuth carboxylates fails to disclose Applicants' claimed method of providing bacterial resistance.

First, one of Kato's two bismuth carboxylates is outside the scope of Applicants' suitable bismuth carboxylates. That is, bismuth citrate is results from a hydroxyl functional aliphatic acid.

Second, Kato's disclosure of bismuth benzoate fails to anticipate Applicants' claimed method. That is, Applicants are not claiming a composition containing a

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bismuth carboxylate made from an aromatic acid. Rather, Applicants' claimed invention is a method of providing bacterial resistance.

Kato fails to anticipate the invention of new claim 19. Kato is silent as to bacterial resistance and the particular attributes of the specific bismuth carboxylates selected by Applicants. As such, Kato fails to place the invention of claim 19 in the possession of the public.

It is therefore respectfully submitted that Kato fails to disclose the invention of Applicants' new claim 19. While a prior art reference need not use the identical terminology, the reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992). Kato fails to meet this standard.

Accordingly, reconsideration and removal of the rejection as to all pending claims is respectfully requested.

B. Rejection under 35 U.S.C. §103(a).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Kato. In particular, Kato fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

In contrast, Kato never mentions the word 'bacteria'. As a result, Kato is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a

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bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Kato discloses a laundry list of suitable bismuth compounds (D) of which only one is suitable for use in Applicants' claimed method. That is, of the seven bismuth containing compounds disclosed by Kato, six would fail to provide any bacterial resistance.

As such, Kato fails to disclose a method of providing bacterial resistance requiring the use of a bactericide comprising a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q. 1673 (Fed. Cir. 1988).

Accordingly, Kato fails to disclose or suggest a method for improving bacterial resistance. Kato cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to any claims dependent thereon.

Reconsideration and removal of the rejection as to all pending claims is respectfully requested.

3. Rejection of claims 1-5 and 9-16 under 35 U.S.C. §102(b) as being anticipated by or in the alternative as being obvious under 35 U.S.C. §103(a) over Sikora, U.S. 6,156,823, hereafter "Sikora" or "823".

A. Rejection under 35 U.S.C. §102(b).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To constitute anticipation, all material elements of a claim must be found in one prior art source. *In re Marshall*, 198 U.S.P.Q. 344 (C.C.P.A. 1978).

Sikora fails to satisfy this standard with respect to Applicants' invention of new claim 19.

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Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

Sikora never mentions the word 'bacteria' or the fact that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance. Rather, Sikora's disclosure with respect to bismuth containing compounds is limited to bismuth trioxide. It is respectfully noted that bismuth trioxide is not a bismuth carboxylate with the scope of Applicants' claim 19.

As such, it is respectfully submitted that Sikora fails to disclose the invention of Applicants' new claim 19. While a prior art reference need not use the identical terminology, the reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992). Sikora fails to meet this standard.

Accordingly, reconsideration and removal of the rejection as to all pending claims is respectfully requested.

B. Rejection under 35 U.S.C. §103(a).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Sikora. In particular, Sikora fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19.

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Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

In contrast, Sikora never mentions the word 'bacteria'. As a result, Sikora is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Sikora's disclosure with respect to bismuth containing compounds is limited to bismuth trioxide. It is respectfully noted that bismuth trioxide is not a bismuth carboxylate with the scope of Applicants' claim 19.

Accordingly, Sikora fails to disclose or suggest a method for improving bacterial resistance. Sikora cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to any claims dependent thereon.

Reconsideration and removal of the rejection as to all pending claims is respectfully requested.

4. Rejection of claims 1-5 and 9-16 under 35 U.S.C. §102(b) as being anticipated by or in the alternative as being obvious under 35 U.S.C. §103(a) over Bossert et al., U.S. 6,124,380, hereafter "Bossert" or "380".

A. Rejection under 35 U.S.C. §102(b).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To constitute anticipation, all material elements of a claim must be found in one prior art source. *In re Marshall*, 198 U.S.P.Q. 344 (C.C.P.A. 1978).

Bossert fails to satisfy this standard with respect to Applicants' invention of new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

Bossert never mentions the word 'bacteria' or the fact that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic

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carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Bossert's disclosure of nine bismuth carboxylates fails to disclose Applicants' claimed method of providing bacterial resistance.

First, four of Bossert's nine bismuth carboxylates are outside the scope of Applicants' suitable bismuth carboxylates. That is, lactic acid, tartaric acid, thioglycolic acid, and mercaptosuccinic acid are all polyfunctional aliphatic carboxylic acids.

Second, Bossert's disclosure of the other five bismuth carboxylates fails to anticipate Applicants' claimed method. That is, Applicants are not claiming a composition containing a bismuth carboxylate. Rather, Applicants' claimed invention is a method of providing bacterial resistance.

Bossert thus fails to anticipate the invention of new claim 19. Bossert is silent as to bacterial resistance and the particular attributes of the specific bismuth carboxylates selected by Applicants. As such, Bossert fails to place the invention of claim 19 in the possession of the public.

It is therefore respectfully submitted that Bossert fails to disclose the invention of Applicants' new claim 19. While a prior art reference need not use the identical terminology, the reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992). Kato fails to meet this standard.

Accordingly, reconsideration and removal of the rejection as to all pending claims is respectfully requested.

B. Rejection under 35 U.S.C. §103(a).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

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expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Bossert. In particular, Bossert fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

In contrast, Bossert never mentions the word 'bacteria'. As a result, Bossert is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Bossert discloses a laundry list of nine bismuth carboxylates suitable as catalysts in his invention. However, only five of the nine catalysts appear to be suitable for use in Applicants' claimed method. That is, of the nine bismuth carboxylates disclosed by Bossert, four would appear to fail to provide any bacterial resistance.

As such, Bossert fails to disclose a method of providing bacterial resistance requiring the use of a bactericide comprising a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (Fed. Cir. 1988).

Accordingly, Bossert fails to disclose or suggest a method for improving bacterial resistance. Bossert cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to any claims dependent thereon.

Reconsideration and removal of the rejection as to all pending claims is respectfully requested.

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3. **Rejection of claims 1-2 under 35 U.S.C. §102(b) as being anticipated by**
McMurdie et al, U.S. 5,972,189, hereafter "McMurdie" or "189".

A. **Rejection under 35 U.S.C. §102(b).**

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To constitute anticipation, all material elements of a claim must be found in one prior art source. *In re Marshall*, 198 U.S.P.Q. 344 (C.C.P.A. 1978).

McMurdie fails to satisfy this standard with respect to Applicants' invention of new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

McMurdie never mentions the word 'bacteria' or the fact that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, McMurdie's disclosure with respect to bismuth containing compounds is limited to bismuth diorganodithiocarbamate. It is respectfully noted that bismuth diorganodithiocarbamate is not a bismuth carboxylate with the scope of Applicants' claim 19.

As such, it is respectfully submitted that McMurdie fails to disclose the invention of Applicants' new claim 19. While a prior art reference need not use the identical terminology, the reference must "sufficiently describe the claimed invention to have placed the public in possession of it." *Minnesota Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 24 U.S.P.Q.2d 1321, 1332 (Fed. Cir. 1992). McMurdie fails to meet this standard.

Accordingly, reconsideration and removal of the rejection as to all pending claims is respectfully requested.

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B. Rejection under 35 U.S.C. §103(a).

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with McMurdie. In particular, McMurdie fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids.

In contrast, McMurdie never mentions the word 'bacteria'. As a result, McMurdie is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, McMurdie's disclosure with respect to bismuth containing compounds is limited to bismuth diorganodithiocarbamate. It is respectfully noted that bismuth diorganodithiocarbamate is not a bismuth carboxylate with the scope of Applicants' claim 19.

Accordingly, McMurdie fails to disclose or suggest a method for improving bacterial resistance. McMurdie cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to any claims dependent thereon.

Reconsideration and removal of the rejection as to all pending claims is respectfully requested.

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6. Rejection of claims 6-8 and 17 under 35 U.S.C. §103(a) as being obvious over Kato et al., U.S. 6,333,367, hereafter "Kato" or "367".

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. It is noted that the rejection is moot with respect to canceled claims 6-8.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Kato. In particular, Kato fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new independent claim 19 and thus amended dependent claim 17.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Claim 17, which depends from independent claim 19, incorporates all of the limitations of claim 19. In addition, claim 17 sets forth two preferred bismuth carboxylates that provide advantageous bacterial resistance.

In contrast, Kato never mentions the word 'bacteria'. As a result, Kato is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Kato discloses a laundry list of suitable bismuth compounds (D) of which only one is suitable for use in Applicants' claimed method. That is, of the seven bismuth containing compounds disclosed by Kato, six would fail to provide any bacterial resistance.

As such, Kato fails to disclose a method of providing bacterial resistance requiring the use of a bactericide comprising a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Where the prior art gives no indication of which parameters are critical and no direction as to

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which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (Fed. Cir. 1988).

Accordingly, Kato fails to disclose or suggest a method for improving bacterial resistance. Kato cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to claim 17 that is dependent thereon.

Reconsideration and removal of the rejection as to claim 17 is respectfully requested.

7. Rejection of claims 6-8 and 17 under 35 U.S.C. §103(a) over Sikora, U.S. 6,156,823, hereafter "Sikora" or "823".

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. It is noted that the rejection is moot with respect to canceled claims 6-8.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Sikora. In particular, Sikora fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19 and thus amended dependent claim 17.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Claim 17, which depends from independent claim 19, incorporates all of the limitations of claim 19. In addition, claim 17 sets forth two preferred bismuth carboxylates that provide advantageous bacterial resistance.

In contrast, Sikora never mentions the word 'bacteria'. As a result, Sikora is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a

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bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Sikora's disclosure with respect to bismuth containing compounds is limited to bismuth trioxide. It is respectfully noted that bismuth trioxide is not a bismuth carboxylate with the scope of Applicants' claim 19.

Accordingly, Sikora fails to disclose or suggest a method for improving bacterial resistance. Sikora cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to claim 17 that is dependent thereon.

Reconsideration and removal of the rejection as to claim 17 is respectfully requested.

8. Rejection of claims 6-8 and 17 under 35 U.S.C. §103(a) over Bossert et al., U.S. 6,124,380, hereafter "Bossert" or "380".

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree. It is noted that the rejection is moot with respect to canceled claims 6-8.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard is not met with Bossert. In particular, Bossert fails to disclose or suggest all of the claimed limitations of the invention set forth in Applicants' new claim 19 and thus amended dependent claim 17.

Independent claim 19 discloses a method for providing bacterial resistance and requires a particular bactericide, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Claim 17, which depends from independent claim 19, incorporates all of the limitations of claim 19. In addition, claim 17 sets forth two preferred bismuth carboxylates that provide advantageous bacterial resistance.

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In contrast, Bossert never mentions the word 'bacteria'. As a result, Bossert is necessarily silent as to any suggestion that a very particular bismuth carboxylate, i.e., a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acid, could provide bacterial resistance.

Rather, Bossert discloses a laundry list of nine bismuth carboxylates suitable as catalysts in his invention. However, only five of the nine catalysts appear to be suitable for use in Applicants' claimed method. That is, of the nine bismuth carboxylates disclosed by Bossert, four would appear to fail to provide any bacterial resistance.

As such, Bossert fails to disclose a method of providing bacterial resistance requiring the use of a bactericide comprising a bismuth carboxylate formed from at least one of aromatic carboxylic acids or monofunctional aliphatic carboxylic acids. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (Fed. Cir. 1988).

Accordingly, Bossert fails to disclose or suggest a method for improving bacterial resistance. Bossert cannot provide a prima facie case of obviousness with respect to Applicants' independent claim 19 or to claim 17 that is dependent thereon.

Reconsideration and removal of the rejection as to claim 17 is respectfully requested.

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CONCLUSION

Applicant(s) respectfully submit that the Application and pending claims are patentable in view of the foregoing amendments and/or remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,



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